

## REMARKS

## INTRODUCTION

In accordance with the following, reconsideration of the allowability of the pending claims is respectfully requested. Claims 1-18 and 22-44 are pending, with claims 1-8, 15-18, 27-33, and 39-44 being under consideration.

## REJECTION UNDER 35 USC §103

Claims 1-8, 15-18, 27-33 and 39-44 stand rejected under 35 USC §103(a) as being unpatentable over Ogihara et al., U.S. Publication No. 2002/0075780. This rejection is respectfully traversed.

It is respectfully submitted that the outstanding rejections based upon a proposed modification of Ogihara et al., as clarified in the Advisory Action issued October 29, 2009, are improper and contrary to MPEP guidelines.

The Advisory Action states:

In response to applicant's arguments on page 9 that it would not have been obvious to a person of ordinary skill in the relevant art to arrive at the technical feature of claim 1 since on or ordinary skill in the art at the time of invention could think that the step/function of comparing LV1 and LV2 is an essential step/function in Ogihara et al., *it is irrelevant whether or not the teaching of Ogihara et al. re considered essential by a person of ordinary skill in the art.* Rather, it is whether or not the rationale for modification is proper, which, as indicated in item 1 above, is consistent with legal precedent.

This disregard for essential elements and operations of Ogihara et al. is improper. Regardless of any rationale for modifying Ogihara et al., that rationale is not sufficient to suggest to remove an essential element or operation from Ogihara et al.

The Advisory Action cites MPEP § 2144, begins with the recitation: "The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law."

However, this citation from MPEP § 2144 ignores the remainder of § 2144.

For example, MPEP § 2144.04 (II) recites:

A. Omission of an Element and Its Function Is Obvious if the Function of the Element Is Not Desired

Ex parte Wu, 10 USPQ 2031 (Bd. Pat. App. & Inter. 1989) (Claims at issue were directed to a method for inhibiting corrosion on metal surfaces using a composition consisting of epoxy resin, petroleum sulfonate, and hydrocarbon

diluent. The claims were rejected over a primary reference which disclosed an anticorrosion composition of epoxy resin, hydrocarbon diluent, and polybasic acid salts wherein said salts were taught to be beneficial when employed in a freshwater environment, in view of secondary references which clearly suggested the addition of petroleum sulfonate to corrosion inhibiting compositions. The Board affirmed the rejection, holding that it would have been obvious to omit the polybasic acid salts of the primary reference where the function attributed to such salt is not desired or required, such as in compositions for providing corrosion resistance in environments which do not encounter fresh water.). See also In re Larson, 340 F.2d 965, 144 USPQ 347 (CCPA 1965) (Omission of additional framework and axle which served to increase the cargo carrying capacity of prior art mobile fluid carrying unit would have been obvious if this feature was not desired.); and In re Kuhle, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) (deleting a prior art switch member and thereby eliminating its function was an obvious expedient).

B. Omission of an Element with Retention of the Element's Function Is an Indicia of Unobviousness

Note that the omission of an element and retention of its function is an indicia of unobviousness. In re Edge, 359 F.2d 896, 149 USPQ 556 (CCPA 1966) (Claims at issue were directed to a printed sheet having a thin layer of erasable metal bonded directly to the sheet wherein said thin layer obscured the original print until removal by erasure. The prior art disclosed a similar printed sheet which further comprised an intermediate transparent and erasure-proof protecting layer which prevented erasure of the printing when the top layer was erased. The claims were found unobvious over the prior art because the although the transparent layer of the prior art was eliminated, the function of the transparent layer was retained since appellant's metal layer could be erased without erasing the printed indicia.).

Likewise, MPEP 2143.01 (V and VI) recites:

V. THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (Claimed device was a blood filter assembly for use during medical procedures wherein both the inlet and outlet for the blood were located at the bottom end of the filter assembly, and wherein a gas vent was present at the top of the filter assembly. The prior art reference taught a liquid strainer for removing dirt and water from gasoline and other light oils wherein the inlet and outlet were at the top of the device, and wherein a pet-cock (stopcock) was located at the bottom of the device for periodically removing the collected dirt and water. The reference further taught that the separation is assisted by gravity. The Board concluded the claims were prima facie obvious, reasoning that it would have been obvious to turn the reference device upside down. The court reversed, finding that if the prior art device was turned upside down it would be inoperable for its intended purpose because the gasoline to be filtered would be trapped at the top, the water and heavier oils sought to be separated would flow out of the outlet instead of the purified gasoline, and the screen would become clogged.).

"Although statements limiting the function or capability of a prior art device require

fair consideration, simplicity of the prior art is rarely a characteristic that weighs against obviousness of a more complicated device with added function." In re Dance, 160 F.3d 1339, 1344, 48 USPQ2d 1635, 1638 (Fed. Cir. 1998) (Court held that claimed catheter for removing obstruction in blood vessels would have been obvious in view of a first reference which taught all of the claimed elements except for a "means for recovering fluid and debris" in combination with a second reference describing a catheter including that means. The court agreed that the first reference, which stressed simplicity of structure and taught emulsification of the debris, did not teach away from the addition of a channel for the recovery of the debris.).

#### VI. THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE

*If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious.* In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (Claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references disclosed an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency. The court reversed the rejection holding the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." 270 F.2d at 813, 123 USPQ at 352.).

Accordingly, the essentiality of the comparing of the LV1 and LV2 signals in Ogihara et al. **cannot** be ignored or discounted, and is primarily relevant.

As noted, as the comparing of the LV1 and LV2 signals in Ogihara et al. are essential features or operations, under either of MPEP §§ 2143 or 2144, it would not have been obvious to modify Ogihara et al., regardless of any rejection rationale presented by the Examiner.

As noted in applicants previous response, Ogihara et al. fails to teach or suggest any technical features to be able to omit the **essential** step/function of comparing LV1 and LV2, if discrimination of only one between a DVD+RW disk and a DVD-ROM disk is desired.

Again, referring to paragraphs 0037 and 0038 of Ogihara et al., the step/function of comparing LV1 and LV2 is described both in the case where a DVD-RW disk is mounted as an optical disk and the case where a DVD+RW disk is mounted as an optical disk. Referring to paragraph 0036 of Ogihara et al., Ogihara et al. discloses the step/function of checking whether or not the relationship of LV1>LV2 is established, as a common step/function, when determining whether the mounted optical disk is a DVD-RW disk or a DVD+RW disk.

Thus, based on the above, since one of ordinary skill in the art at the time of invention

would necessarily understand that the step/function of comparing LV1 and LV2 is an essential step/function in Ogihara et al., it would not have been obvious to a person of ordinary skill in the relevant art to arrive at the above technical feature of claim 1 of the present.

Accordingly, the applicant respectfully requests that the rejections of claim 1 of the present application and its dependent claims 2-5 based on the Examiner's assertion above be withdrawn. Claims 6-8, 15, and 27, respectively, recite technical features similar to claim 1, with differing scope and breadth, and thus Claims 6-8, 15, 27 and their dependent claims are also patentable for at least the same reasons as those of claim 1.

If the Examiner maintains this rejection, applicants respectfully request a detailed explanation as to (1) why the comparison of the LV1 and LV2 signals would not have been essential, (2) why it would have been obvious to omit the essential step/function of comparing LV1 and LV2, if discrimination of only one between a DVD+RW disk and a DVD-ROM disk is desired, and (3) why the Office Action's proposed rationale for modifying Ogihara et al. outweighs the aforementioned non-obviousness reasons for not modifying Ogihara et al., as proposed. Here, it is noted that factors supporting obviousness must outweigh any factors supporting non-obviousness to meet an obviousness case.

Withdrawal of the outstanding rejections is respectfully requested.

## CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

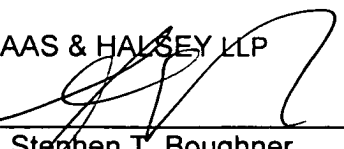
Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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